

## PATENT

Coming up with a big idea is just the beginning. To protect the rights of innovators and inventors, Armstrong Teasdale lawyers provide patent services to some of the world's largest companies with innovation at the heart of their business, managing portfolios containing thousands of patents.

Our patent team includes over 50 lawyers and patent agents registered to practice before the U.S. Patent and Trademark Office. The team has filed 14,668 patent applications in the last five years, with 2,894 of those originally drafted and filed. We also serve individual inventors as well as university tech-transfer programs, research facilities and technology incubators.

We represent clients around the globe from offices across the United States. Our team includes lawyers, patent engineers and patent agents with advanced degrees, including Ph.D.s, and practical experience that enable them to develop optimal protection strategies for our clients' inventions and ideas, both in the United States and internationally. Many of our patent professionals have degrees and experience in fields encompassing biotechnology, electrical engineering, computer science and the mechanical arts, giving them the technical knowledge to support clients working in a broad range of industries, including:

- Aerospace design
- Automotive technology
- Autonomous vehicle technology
- Biological therapies
- Biological and genetic markers
- Business methods
- Chemical engineering
- Computer science
- Confectionary products
- Consumer appliances
- Data storage systems
- Database management
- Food science
- Fuel cell and battery technology
- Gaming systems and technology
- Genetic therapies
- Genetically modified organisms (GMOs)
- Genetically modified (GM) seeds
- Herbicides
- Hygiene products

- Immunotherapy
- Immunooncology
- Medical devices and diagnostics
- Microfluidic devices
- Mobile technologies
- Nanomaterials
- Network technologies
- Organic chemistry
- Online advertising technologies
- Pesticides
- Pharmaceutical compositions
- Polymer/material science
- Power generation systems
- Prebiotics/probiotics
- Product packaging
- Rail car technology
- Security systems
- Small molecules
- Space and satellite technology
- Textile technology
- Transportation systems
- Vaccines
- Vehicle technology
- Wind energy technology

Our services include:

- preparing and prosecuting patent applications;
- conducting patentability, noninfringement, clearance and validity studies;
- performing due diligence studies related to acquisitions; and
- assisting clients in the development, management and monetization of patent portfolios.

Members of our team are also experienced trial lawyers with significant IP litigation and post grant proceedings experience. We serve both patent owners and petitioners before the Patent Trial and Appeal Board (PTAB) at the U.S. Patent and Trademark Office (USPTO) in post grant proceedings, including post grant review (PGR), *inter partes* review (IPR) and derivation proceedings.

## EXPERIENCE

### **Secured Dismissal of \$35 Million Claim for Infringement**

Successfully defended a corporation against allegations of patent infringement and copyright infringement in federal court, resulting in dismissal of all counts.

### **\$132 Million Sale of Patent Pool Administrator**

Represented a minority owner in the \$132 million sale of a patent pool administrator to another patent pool administrator in the audio and video coding technology space.

### **\$65 Million Sale of Specialty Home Furnishings Business**

Represented the seller, a manufacturer of specialty home furnishings, in its acquisition by a leading brand aggregator in numerous different consumer products spaces. The sale, for \$65 million in cash and equity, represented the buyer's first acquisition in the home furnishings space. We also provided counsel on employment, employee benefits, tax, patent, and intellectual property aspects of the transaction.

### **Patent Portfolio for Semiconductor Materials Supplier**

Managing U.S. and international patent portfolios for a leading materials supplier to the semiconductor industry.

### **Oversight of Significant Global Patent Portfolio**

Oversaw a worldwide intellectual property portfolio consisting of approximately 11,000 trademark filings, over 70 patent filings and over 8,000 domain names.

### **Successful Defense of Game-Changing Technology for Agricultural Manufacturer**

Successfully defended game-changing agricultural equipment patents before the USPTO during reexamination related to a pending infringement suit in which the major manufacturer is the plaintiff.

### **Trademark Portfolio for Global Packaging Company**

Managing the trademark portfolio for a major global packaging company.

### **Successful PTAB Administrative Appeal**

Won an administrative appeal for a global technology company before the U.S. Patent Trial and Appeal Board in a case involving a patent application that sought to protect a method of predicting a consumer's future purchases, based on previous transaction card purchases indicating that a "life event" had recently occurred for the consumer. The United States Patent and Trademark Office had rejected the application as directed to an abstract idea under a 2014 Supreme Court case. In its decision in favor of the client, the Appeal Board held that any abstract idea was integrated into a practical application because the patent claims "improve the underlying consumer behavior prediction technology."

### **Noninfringement Opinion for Biotech Startup**

Prepared a noninfringement opinion for a startup biotech company in order for the company to receive funding.

### **Patent Portfolio Strategy for University Covering Pharmaceuticals, Life Sciences and Medical Fields**

Developed and executed patent filing strategy and managed diverse patent portfolio for a large university client. Technologies span various subject areas including pharmaceuticals, life sciences and medical fields.

### **Advised on Paragraph (iv) Certification Strategy Related to Development of Generic Pharmaceuticals**

Advised in-house counsel on paragraph (iv) certification strategy and provided related opinion work, including noninfringement and invalidity analyses of competitor patents in support of Hatch-Waxman litigation. Further advised on design-around and re-formulation strategies.

### **Patent Portfolio Strategy for University Covering Science, Engineering and Medical Fields**



Developed and executed patent filing strategy and managed diverse patent portfolio for a large university client. Technologies span various subject areas including science, engineering and medical fields.

**Successful Enforcement of Global Intellectual Property Rights**

Enforced and defended trademarks, copyrights and patent rights for a jewelry designer and retailer against third-party infringers.

**Advised on Patent Matters Related to Automotive Technologies**

Advised in-house counsel on patent-related matters, including noninfringement and invalidity analyses of competitor patents. Prepared and prosecuted patent applications directed to variety of automotive technologies including automotive manufacturing, infotainment systems, electric vehicle (EV) charge controllers, audio systems, suspension systems and other mechanical systems.

**Developed, Executed Patent Filing Strategy Central to Multimillion-Dollar Acquisition for Client**

Developed and executed patent filing strategy resulting in patent family that was central to multimillion-dollar acquisition by large, publicly traded fluidics systems and specialty engineered products company.

**Domestic and Foreign Patent Strategy and Portfolio Management for Agricultural Equipment Company**

Developed and executed domestic and foreign patent filing strategy and management of patent portfolio related to precision agricultural equipment, including the development of offensive and defensive patent filing strategies.

**Filed University's First Ever Patent Applications**

Filed the first ever patent applications for a university client. Worked with the university to create and implement internal intellectual property procedures for the client.

**Inter Partes Review for Multinational Security Company**

Handled four different *inter partes* reviews for multinational company specializing in security and identity solutions.

**IP Agreements for Health Client Entering Third-Party Partnerships**

Prepared various IP-related agreements including licenses, commercialization and joint development agreements, enabling client to successfully enter into partnerships with third parties.

**IP Due Diligence Review for Billion-Dollar Fragrance, Flavors Company**

Managed large IP due diligence review for a billion-dollar fragrance and flavors company leading up to a significant acquisition.

**Managed International Patent Portfolio for Health Care Company**

Managed U.S. and international patent portfolio related to heart pumps, cardiac catheters, electrocardiograms, heart mapping, heart monitoring and ablation therapy technologies.

**Managed Multiple International Patent Portfolios for Manufacturer**

Provided development and strategic counsel oversight for multiple U.S. and international patent portfolios for commercially valuable products and systems of a multinational electrical product manufacturer for more than 20 years.

**Management of U.S. and Foreign Patent Families for Major Medical Device Companies**

Managed multiple U.S. and foreign patent families and provided strategic counsel for medical device companies involving technologies related to fluorescent imaging, vascular occlusion, neuromodulation, and renal and cardiovascular devices.

**Patent Clearance Projects in Pharmaceutical Industry**

Managed several patent clearance projects relating to a computer ecosystem designed to manage the prescription process and use by patients of a multimillion-dollar pharmaceutical product.

**Patent Counsel to Global Chemical Company**



Providing freedom to operate, noninfringement and invalidity opinions for a major global chemical manufacturer.

**Patent Infringement, Invalidity Analysis Relating to Display Screen Technology**

Managed patent infringement and invalidity analysis for a client in the area of display screen technology. This involved numerous design patents covering various types of display screens.

**Patent Landscape Analysis for Fintech Client**

Conducted patent landscape analyses and ideation sessions for a large fintech client in the area of authenticating online users.

**Patent Portfolio Development Related to Autonomous Vehicles**

Led a team of patent attorneys to prepare and file several patent applications for a large client directed to the control, management and diagnostic testing of autonomous vehicles.

**Patent Portfolio in Touch Screen Technology**

Managed the filing of a portfolio of patent applications for an international client in the touch screen technology area.

**Patent Portfolio Management for Multinational Aerospace Corporation**

Managed patent applications relating to semiconductors, avionics, antennas, modeling, simulation, non-destructive testing, flight control systems, communication systems, electronics and unmanned systems.

**Payment Authentication Patent Portfolio for Fintech Client**

Developed patent portfolio for large fintech client in the area of payment authentication services. Multiple patent attorneys prepared and filed numerous patent applications directed to authenticating online users using client device metadata.

**Pharmaceutical Patent Portfolio for University**

Managed pharmaceutical patent portfolio that includes filings in over 16 different countries. Worked with university and licensee on achieving patent protection worldwide.

**Portfolio Management, Strategic Direction for Multiple Consumer Products, Health Care Companies**

Managed global patent portfolios for and provided strategic counsel to multimillion-dollar consumer products and health care companies in the U.S. and abroad, including preparation and prosecution, opinion work, *Inter Partes* Review work and litigation.

**U.S. National Applications for Multibillion-Dollar Foreign Clients**

Managed the filing and prosecution of extensive U.S. National (371) applications for a number of multibillion-dollar foreign clients. Armstrong Teasdale represents clients based in China, Japan, Singapore, the United Kingdom, Germany, Australia and many other countries.

**Due Diligence for Multinational Chemical Company**

Managed significant due diligence project for multinational chemical company. The project included clearing the client's product through a freedom-to-operate opinion and also identifying any potentially problematic references owned by competitors.

**Prepared Invalidity Opinions for Client's New Product Release**

Prepared over a dozen invalidity opinions on competitors' patents that presented a potential issue for a global client's release of a new product.

**Secured Dismissal for Biometric Solution Client in Patent Infringement Case**

Obtained voluntary dismissal with prejudice of a patent infringement case brought by a patent assertion entity against biometric solution client.

**Summary Judgment for Manufacturer in Patent Case**



Obtained summary judgment and favorable resolution for our client, a major manufacturer, regarding six patents in U.S. District Court for the Eastern District of Missouri.

**Patent Preparation and Prosecution for Leading Consumer Electronics Company**

Prepared and prosecuted patent applications for leading consumer electronics company for technologies relating to wearable and telecommunication devices.

**IP Due Diligence in \$3.4 Billion Acquisition of Medical Device Manufacturer**

Led IP due diligence for a major medical device company, including in-depth research and analysis of both the target company and its competitors, resulting in our client's decision to move ahead with its \$3.4 billion acquisition of a medical device manufacturer.

**Patent Clearance for Auto Manufacturer's New Product Line**

Oversaw the clearance of a new product line for a large automobile manufacturer. The new product line was in a complex and technical field that had required a detailed understanding and clearance of over 800 competitor patents in a relatively short time period.

**Successfully Defended Snack Chip Manufacturer Against Infringement, Other Claims**

Successfully defended client against claims of patent infringement, trademark infringement, trade secret misappropriation and unfair competition brought by leading manufacturer of snack chips. Secured a defense verdict on all claims.

**Conducted Competitive Strategy Projects for Pharmaceutical Company**

Ran year-long competitive strategy projects for multinational client. The projects included in-depth analyses and presentations on competitors' complete intellectual property portfolios, including freedom-to-operate positions, invalidity opinions and strategic patent application filings to gain a competitive edge.

**Patent Portfolio Review for Multinational Client**

Conducted a week-long review of every patented product of a multinational client's portfolio at their facilities. After the review, prepared an in-depth analysis of the patent term/life of each of the respective products.